

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. JONES
And NANCY S. CLUNGEON

Appeal No. 2005-1670
Application 09/898,341

ON BRIEF

Before GARRIS, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (September 2004); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

The claims on appeal are represented by claim 1:

1. A soft highly absorbent tissue product comprising long paper making fibers, a surface active agent, and a ketene dimer sizing agent.

We interpret appealed claim 1 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage as they would be understood by one of ordinary skill in the art in light of the written description in the specification as interpreted by this person, unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claim any limitation or particular embodiment

disclosed in the specification.. See, e.g., *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The plain language of claim 1 specifies any “soft highly absorbent tissue product” comprising at least some amount, however small, of long paper making fibers, some amount, however small, of any surface active agent and some amount, however small, of any ketene dimer sizing agent, wherein the transitional term “comprising” opens the claim to any “soft highly absorbent tissue product” that contains any manner and amount of additional ingredients. See *Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

The terms “soft” and “highly absorbent” are terms of degree for which the specification must either provide a definition or some standard of measurement, or the terms will be given their ordinary meaning. See *Morris, supra*; *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622-23 (Fed. Cir. 1996); *Seattle Box Co., Inc. v. Industrial Crating & Packing Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984) (“Definiteness problems arise when words of degree are used. That some claim language may not be precise, however, does not automatically render a claim invalid. When a word of degree is used . . . [it] must [be determined] whether the patent’s specification provides some standard for measuring that degree.”); *In re Marosi*, 710 F.2d 799, 802-03, 218 USPQ 289, 292 (Fed. Cir. 1983), citing *In re Mattison*, 509 F.2d 563, 564-65, 184 USPQ 484, 486 (CCPA 1975).

In this respect, we find in the written description in the specification the disclosure that “the rate of water absorption and the total amount of water that sheet softened with a ketene dimer sizing agent and wetting agent can absorb is not materially different from an equivalent sheet that does not have those agents” (page 7, ll. 24-27). However, as we determined above, there is no limitation on the amount of surface active agent and ketene dimer sizing agent contained by the claimed tissue product as encompassed by claim 1, and it appears from the

disclosure in the specification that “a soft highly absorbent tissue product” can be obtained with little, if any, amount of either or both of these agents.

Considering now the examiner’s application of the combined teachings of Voigtman et al. (Voigtman), Donnelly, Osberg, the admitted state of the art on pages 1, 2 and 5 of the specification, Ampulski et al. (Ampulski) and Wendt et al. (Wendt) to appealed claim 1, as we have interpreted this claim above, under 35 U.S.C. § 103(a) (answer, pages 3-7), we find that the examiner has not identified in Voigtman, Donnelly, Osberg or Wendt any ingredient combined in any amount with a ketene dimer sizing agent in a dispersion or emulsion that is in fact a surface active agent, or any ingredient that is in fact a surface active agent which is reasonably taught by the references to be used with a ketene dimer sizing agent in any amount in a dispersion or emulsion. For example, we find that Voigtman does disclose emulsions of a ketene dimer sizing agent in Examples I and II thereof but does not disclose the emulsifier, and Osberg does evince that dispersions or emulsions of a ketene dimer sizing agents are conventional practice in the art, as the examiner points out (answer, pages 3 and 4). However, the examiner does not contend that any of the dispersants or emulsifiers used to form the dispersions or emulsions containing a ketene dimer sizing agent in Osberg, for example, is/are in fact surface active agents.

It seems to us that among the dispersants or emulsifiers disclosed in Osberg are recognized surface active agents. For example, we find in this respect that Ampulski at col. 5, ll. 33-35, would have suggested to one of ordinary skill in this art that polyoxyethylene sorbitan trioleate disclosed by Osberg at col. 6, ll. 65-68, is a nonionic surface active agent, and that this compound thus falls within the broad term “surface active agent” in claim 1 (*see* specification, sentence bridging pages 4-5). We further find that Osberg refers to ketene dimer emulsions disclosed in United States Patent 2,785,067 to Downey (Osberg, e.g., col. 1, ll. 25-29, and col. 6, ll. 62-63), which patent is not of record.

We find that the examiner has cited admitted prior art on page 5 of appellants’ specification but has not explained the relevance of that citation in the same manner as that on pages 1-2 of the specification (answer, pages 3 and 5).

Furthermore, in the statement of the ground of rejection of appealed claims 18 through 20 under the judicially created doctrine of obviousness-type double patenting over claims 1 through

10 of McFarland et al, (McFarland), the examiner states that the appealed claims are not patentably distinct from the patent claims because “the present claims are open to multi-suspension headbox for making the absorbent paper” (answer, page 6). However, in response to appellants’ arguments, the examiner states that the appealed claims “are open to the surfactant and multi-suspension headbox claimed in McFarland” without identifying the basis for finding the “surfactant” in the patent claims (answer, page 7).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider the issues that we have raised above with respect to the teachings of the references applied to the appealed claims under 35 U.S.C. § 103(a) as well as consideration of Downey in this respect, and the scope of the invention encompassed by the claims of McFarland, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the grounds of rejection advanced on appeal. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, “appellant must within two months from the date of the supplemental answer’s answer exercise one of” the two options set forth in 37 CFR §1.41.50(a)(2) (September 2004), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provide in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP § 1211 (8th ed., Rev. 2, May 2004; 1200-30).

Remanded

Bradley R. Larix

BRADLEY R. GARRIS
Administrative Patent Judge


CHARLES E. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Robt F. Kraft

PETER F. KRATZ
Administrative Patent Judge

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